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In re Application of:
Harry Contopanagos et al.
Serial No.: 10/074,293
Filed: February 12, 2002
Attorney Docket No.: BP 2108

DECISION ON PETITION

This is a decision on the petition entitled "PETITION PURSUANT TO 37 CFR 1.144 and/or 1.181 TO WITHDRAW NOTICE OF ABANDONMENT" filed on January 13, 2005. There is no fee for this petition.

The petition is **DISMISSED**.

On August 13, 2002, a restriction requirement between two inventions was mailed to applicant. Applicant responded by facsimile transmission on June 2, 2003. As indicated by the Certificate of Mailing on the response, the facsimile transmission was apparently a copy of the response that was mailed to the Office on September 13, 2002. Although there was no statement under 37 C.F.R. § 1.8(b)(3), the response of June 2, 2003 was accepted by examiner. The response elected with traverse Group I, claims 1-15.

On June 27, 2003, the examiner sent another restriction requirement requiring an election between 8 species identifying the different species by reference to different figures of the drawings. On October 2, 2003, applicant timely responded to the restriction requirement by merely reaffirming the election of claims 1-15. On December 31, 2003, a letter was mailed to applicant indicating that the response of October 2, 2003 was not fully responsive to the restriction requirement of June 27, 2003 since applicant failed to elect a species to be examined.

On March 8, 2004, applicant timely responded to the letter by contending that the restriction requirement between species was inappropriate and again did not make an election between the given species. On April 9, 2004, examiner sent another letter indicating that the response of March 8, 2004 was not fully responsive to the prior Office Action since applicant failed to elect a species to be examined. In this letter, examiner gave a listing of the claims readable on the respective species. The letter stated that since the response did not appear to be a bona fide attempt to further prosecution, the period for response continued to run from the mailing date of the previous letter, i.e., December 31, 2003.

On July 2, 2004, applicant filed a timely reply to the letter of April 9, 2004. The reply was timely due to the 2 month extension of time filed with the response of March 8, 2004 and the

3 month extension of time and Certificate of Mailing dated June 28, 2004 filed with the reply of July 2, 2004. Again, the applicant indicated his disagreement with the restriction requirement but failed to elect.

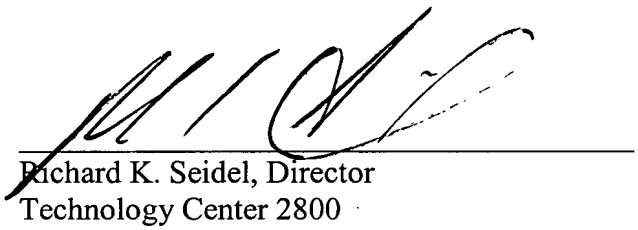
On November 18, 2004, a Notice of Abandonment was mailed to applicant indicating the application was abandoned in view of applicant's failure to timely file a proper reply to the Office letter mailed on October 2, 2003. It further stated that applicant's replies filed on 03/08/04 and 07/02/04 were not proper replies because applicant did not provisionally elect a single disclosed species and as noted in 37 CFR 1.143, a provisional election must be made even though the requirement is traversed (see MPEP 818.03(b)).

Although the Notice of Abandonment listed the wrong date of the Office letter to which applicant failed to timely file a proper reply, the rest of the Notice of Abandonment was correct. When applicant was sent the restriction requirement on June 27, 2003, it was incumbent on the part of the applicant to elect a species even though he did not agree with the restriction requirement. It was irrelevant that the examiner did not list the claims readable on the respective species (as later done in the letter of April 9, 2004). Applicant still could have and was required to elect one of the 8 species listed in the Office action of June 27, 2003.

When applicant failed to make an election after several opportunities to do so, the application was correctly abandoned. Petitioner has presented no argument as to why he believes the holding of abandonment to be in error except to state that the holding should be withdrawn since the patent application became abandoned due to the inappropriate species election requirement. However, it is not germane to the holding of abandonment whether or not the restriction requirement was appropriate or proper. As indicated earlier, 37 C.F.R 1.143 and MPEP 818.03(b) both note that a provisional election to a restriction requirement must be made even though the requirement is traversed.

Accordingly, the petition to withdraw the holding of abandonment is dismissed and the application remains in abandoned status. At this time, the arguments presented as to the propriety of the restriction requirement will not be considered since the application is abandoned and no election was made during the pendency of the application.

Any inquiries regarding this decision should be directed to Edward Westin at (571) 272-1638.



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